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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,704	02/06/2004	Armin Diez	HOG610C	8289
7590	02/02/2006		EXAMINER LEE, GILBERT Y	
Edward J. Timmer P.O. Box 770 Richland, MI 49083-0770			ART UNIT 3673	PAPER NUMBER
DATE MAILED: 02/02/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/773,704	DIEZ ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Gilbert Y. Lee	3673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 24,26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24,26 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/2/04</u> .  | 6) <input type="checkbox"/> Other: ____                                     |

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities: Page 1, 1<sup>st</sup>

Paragraph: --This application is a Continuation of Application 10/052468 filed

1/23/2002, now U.S. Patent No. 6769696.--

Appropriate correction is required.

2. The abstract of the disclosure is objected to because it exceeds the 150 word maximum. Correction is required. See MPEP § 608.01(b).

### *Claim Objections*

3. Claim 24 is objected to because of the following informalities: In line 1, "Cylinder head" should be changed to --A cylinder head--, "an at least" should be changed to --at least one--, in line 2 "gasket plate comprising" should be changed to --gasket plate, the head gasket comprising--, and in line 4 "each being surrounded" should be changed to --each of said chamber openings being surrounded--. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear to the examiner as to what "thickness" the applicant is referring to in claim 26. There are two ways the "thickness" can be defined: 1) the height of the bead or deformed sheet metal layer compared to a common plane or 2) the thickness of the material. For the purposes of this examination, the examiner is interpreting the claim as to mean the latter of the two (the thickness of the material).

#### ***Obviousness-Type Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 24, 26, and 27 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 9, 12, 21 and 22 of U.S. Patent No. 6,769,696. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claimed invention is somewhat broader in recitation of the '696 Patent.

In section a of claim 24 of the present claimed invention and claim 21 of '696 Patent, the Applicants claim: "said delimiting device is formed by at least one second bead...surrounding the associated combustion chamber opening...a substantially complete meander extending in a circumferential direction of said combustion chamber opening", whereas in '696 Patent, the Applicants claim "the elevations are formed by at least one additional bead...surrounds the combustion chamber opening...a substantially complete meander extending in a circumferential direction of the combustion chamber opening" (see Col. 16, Lines 43-49).

In section b of claim 24 of the present claimed invention and claim 9 of '696 Patent, the Applicants claim: "the spring rate of the second bead is greater than the spring rate of the associated first bead", whereas in '696 Patent, the Applicants claim "the spring rate of the delimiting device...is greater than that of the neighboring bead" (Col. 16, Lines 7-10).

In section c of claim 24 of the present claimed invention and claim 12 of '696 Patent, the Applicants claim: "the second bead is disposed between the associated combustion chamber opening and the associated first bead", whereas in '696 Patent, the Applicants claim "the delimiting device is arranged radially within the neighboring bead" (Col. 16, Lines 18-20).

In section d of claim 24 of the present claimed invention and section d of claim 1 of '696 Patent, the Applicants claim: "the height of the second bead is selected so as to allow an elastic deformation of the associated first bead", whereas in '696 Patent, the Applicants claim "the deformability in height of said elevations is smaller than the deformability in height of said bead" (Col. 15, Lines 39-40).

In section d of claim 24 of the present claimed invention and section d of claim 1 of '696 Patent, the Applicants claim: "the total area occupied by the second bead is at least equal to half of the total area occupied by said delimiting device", whereas in '696 Patent, the Applicants claim "the total area occupied by all of said elevations is at least equal to half of the total area occupied by said delimiting device" (Col. 15, Lines 27-30).

Therefore, in respect to above discussions, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of claims

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1, 9, 12, 21 and 22 of '696 Patent as a general teaching for a cylinder head gasket with a first bead and a second bead comprising a delimiting device with a meander to perform the same functions as claimed by the present application. The instant claims obviously encompass the claimed invention of '696 Patent and differ only in terminology. To the extent that the instant claims are broader and therefore generic to the claimed invention of '696 Patent [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously claimed in a co-pending application.

#### ***Allowable Subject Matter***

7. Claims 24, 26, and 27 would be allowable over the prior art of record after timely filing of a terminal disclaimer.

#### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ishikawa et al. (US Patent No. 5,427,389), Takada et al. (US Patent No. 5,626,348), Plunkett (US Patent No. 6,089,572), Miyaoh (US Patent No. 5,961,126), Ishii et al. (US Patent No. 4,739,999), Hohe et al. (US Pub. No. US 2004/0041352 A1), Egloff (US Patent No. 6,918,597), and Egloff (German Patent No. DE 10029352 A1).


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gilbert Y. Lee whose telephone number is 571-272-5894. The examiner can normally be reached on 8:00 - 4:30, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jong-Suk (James) Lee can be reached on (571)272-7044. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GL  
1/19/06

  
JONG-SUK (JAMES) LEE  
PRIMARY EXAMINER  
3673